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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/240,053	01/29/1999	CLEMENT W. BOWMAN	PROGRID	6857
22191	7590	05/05/2004	EXAMINER	
GREENBERG-TRAURIG 1750 TYSONS BOULEVARD, 12TH FLOOR MCLEAN, VA 22102			KALINOWSKI, ALEXANDER G	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/240,053

Applicant(s)

BOWMAN, CLEMENT W.

Examiner

Alexander Kalinowski

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mlw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-20 are presented for examination. Applicant filed an amendment submitting arguments traversing the outstanding rejection of claims 1-20 based on 35 USC 103. After careful consideration of Applicant's arguments, the Examiner withdraws the rejection of claim 1-20 based on 35 USC 103. new grounds of rejection are established in the instant office action as set forth in detail below.

Response to Amendment

2. The declarations under 37 CFR 1.132 filed 2/20/2004 are insufficient to overcome the rejection of claim 1-20 based upon 35 USC 103 as set forth in the last Office action because the declarations present personal opinions not facts to attempt to establish the nonobviousness of the claimed invention under secondary considerations. The declaration of John C. Bowman is ineffective based on the relationship between Dr. Bowman and the inventor. Dr. Bowman is the inventor's brother. Therefore, the declaration is not effective since Dr. Bowman would tend to be seen as biased with respect to the instant application based on his relationship with the inventor. In the declaration, Dr. Bowman asserts that the references used by the Examiner could not be combined to reject the claimed invention.

Furthermore, the declaration of Dr. Peter Morand also asserts that the references used by the Examiner could not be combined to reject the claimed invention. Dr. Morand further states that this assertion is based on his opinion. For example, Dr. Morand addresses the references separately pointing out deficiencies of each reference with

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respect to the claimed invention. However, the declaration fails to discuss how the combination fails to disclose the claimed invention or why there would be no motivation to combine the references. The last declaration by J. Ronald McDonough asserts that the invention is useful and better than other products sold by competitors. The Examiner notes that Mr. McDonough is an officer within Pro-Grid Ventures which is an assignee of the current invention. Furthermore, although Mr. McDonough has included testimonials from customers who purchased the Pro-Grid product, testimonials in and of themselves do not establish facts or evidence necessary to establish secondary considerations asserted by Applicant. Due to the nature of Mr. McDonough's relationship with the Inventor and the claimed invention and the absence of evidence in the declaration, this declaration is ineffective.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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In claim 1, the limitation of “establishing a first independent variable and a second independent variable related to the value of said specific intangible asset of interest” is not enabled. The specification, although stating that this is accomplished by the claimed method, does not provide any explanation as to how this step is accomplished. At best, the specification provides some examples of specific variables that Applicant asserts are independent variables. 9see page How are the independent variables established? How does one determine if the variables are independent? What is meant by the phrase independent variables? How does one determine which variables are independent and which variables are dependent ? For purposes of applying prior art, the Examiner will not consider that the variables must be independent.

Furthermore, the limitation of “establishing a series of performance criteria statements probative of the value of said first and second independent variables” is also not enabled by the specification. The specification at page 7 refers to Figures 1a-1d as examples of performance matrices and Figure 2 as an example of performance criteria. However, the specification does not explain how to select the performance in order that the performance criteria statements are probative of said first and second independent variables. In other words, do the performance criteria depend on the independent variables that are selected? Once the independent variable have been established, how do you select the performance criteria?

5. Claims 2-20 are similarly rejected under 35 U.S.C. 112, first paragraph based on their dependency to claim 1.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-18 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Blake et al., "The Managerial Grid"(hereinafter The Managerial Grid) in view of Canguilhem, Pat. No. 3,628,904 and Hamel et al., "Competence-Based Competition" (hereinafter Hamel).

As for claim 1, applicant cites a method of evaluating an intangible asset of interest which comprises the steps of: establishing first and second variables related to the value of the intangible asset of interest; establishing a series of performance criteria statements for the value of the first and second variables; scoring each of said performance criteria statements; summing a plurality of scores to generate first and second total scores based upon the extent to which individual statements accurately describe the intangible asset of interest; transforming physical media into a chart having a first and second axes each of which relates to one of the variables; physically plotting a point on the chart at the location that corresponds to the first and second total scores

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and using the chart in making a decision regarding the value of the intangible asset of interest.

The Managerial Grid discloses two variables (concern for people and concern for production); various criteria statements (the five statements shown in Fig. 1); first and second scores (1,1; 9,9; 1,9 etc.); a chart with two axes each relating to one of the variables (concern for people and concern for production) and plotting a point on the chart corresponding to the first and second total scores (1,1; 9,9; 1,9 etc.).

The Managerial Grid does not teach the use of the chart in making a decision regarding the value of the asset.

However, Canguilhem discloses that graphical illustrations are used to represent quantitative measures to subjective concepts in order to create a user friendly illustration or depiction of abstract data and data trends and to facilitate decision making (see abstract, Fig. 4, 7, 9, and 10, col. I, lines 5-30 and col. 4, lines 5-12). It would have been obvious to one of ordinary

skill in the art to have included the use of the chart in making a decision regarding the value of the asset as disclosed by Canguilhem within The Managerial Grid for the motivation of creating a user friendly illustration or depiction of abstract data and data trends and to facilitate decision making (col. I, lines 5-30).

The Managerial Grid does not explicitly disclose

using a printer to transform physical media, by physically plotting a chart.

However, Canguilhem discloses using a printer to transform physical media, by physically plotting a chart (i.e. output device)(see Fig. 4, 7, 9, 10 and 12, and col. 19,

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lines 27-30). It would have been obvious to one of ordinary skill in the art to have included using a printer to transform physical media, by physically plotting a chart as disclosed by Canguilhem within The Managerial Grid for the motivation of creating a user friendly illustration or depiction of abstract data and data trends and to facilitate decision making (col. I, lines 5-30).

The Managerial Grid and Canguilhem do not explicitly disclose a first independent variable and a second independent variable related to a specific intangible asset of interest.

However, Copeland discloses a method including first independent variable and a second independent variable related to a specific intangible asset of interest (i.e. DCF approach)(see Fig. 3.4, 3.6, 3.7, Ch. 3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to the aforementioned limitation as disclosed by Copeland within the Managerial Grid and Canguilhem for the motivation of providing a more sophisticated and reliable picture of a company's value (page 75).

The Managerial Grid and Canguilhem do not explicitly disclose scoring each of the performance criteria statements to produce a plurality of scores which reflect the applicability of said performance criteria statements to said intangible asset of interest. However, Hamel discloses scoring each of the performance criteria statements to produce a plurality of scores which reflect the applicability of said performance criteria statements to said intangible asset of interest (i.e. Skill Mapping, Opportunity Matrix, Skillbase Simulation, Skill Cluster Analysis, Critical Skill Analysis)(Ch. 8). It would have been obvious to one of ordinary skill in the art at the time

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of Applicant's invention to include scoring each of the performance criteria statements to produce a plurality of scores which reflect the applicability of said performance criteria statements to said intangible asset of interest as disclosed by Hamel within the Managerial Grid, Canguilhem, and Copeland for the motivation of providing practical toolkits to use competency based analysis or strategies (Ch. 8).

As for claim 2, applicant further claims the generating step as comprising: choosing criteria statements which most closely describe the asset being evaluated, determining first and second scores for each of the criteria statements and summing the scores for the first and second variables. The Managerial Grid discloses the use of criteria statements and scores of each of these statements with respect to each of the variables.

As for claim 3, The Managerial Grid does not explicitly disclose the method of claim 1 further comprising the steps of assigning first and second weighing factors reflecting the extent of impact of the criteria statements on the first and second variables and using the weighing factors in determining first and second total scores.

However, Canguilhem discloses the steps of assigning first and second weighing factors reflecting the extent of impact of the criteria statements on the first and second variables and using the weighing factors in determining first and second total scores (i.e. greater importance attributed to certain factors relative to others)(col. 2, lines 60-67). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the steps of assigning first and second weighing factors reflecting the extent of impact of the criteria statements on the first and second variables

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and using the weighing factors in determining first and second total scores as disclosed by Canguilhem within the Managerial Grid for the motivation of providing quantified values for concepts which are of a subjective nature (col. 2, lines 20-26).

As for claim 4, applicant cites a method of placing a label in each of the four quadrants of the chart of claim 1 to represent the extent to which points in a quadrant reflect balance between the first and second variables. The Examiner takes official notice that it was well known in the statistical arts that the quadrants of a graph provide an indication of the comparative value of each of two variables which define the axis of the graph. Such labeling provides a key as to what that

area of the graph represents and it would have been obvious to one of ordinary skill in the art to include this feature within the Managerial Grid for the motivation stated above. As for claims 6-17, applicant cites the various types of assets being evaluated and a corresponding set of variables for each of these assets. The Managerial Grid does not explicitly disclose this feature.

However, the Managerial Grid discloses evaluating a specific asset and a corresponding set of variables for the specified asset related to the performance of an organization or asset (i.e. Management's concerns for production versus management's concerns for its employees)(see The Managerial Grid). It would have been an obvious to one of ordinary skill in the art to have utilized The Managerial Grid for evaluating other types of assets that are related to the performance or value of the asset in order to customize the Grid for particular preferences and/or needs of the user of the system.

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As for claim 18, applicant cites a chart created by the method of claim 1 for providing a graphical indication of the value of an intangibles asset of interest.

The use of graphical illustrations to represent data was well known in the statistical arts and this limitation was previously discussed in claim 1 above.

8. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Managerial Grid, Canguilhem, Copeland and Hamel as applied to claim 1 above, and further in view of Turnbull, Peter, "A Review of Portfolio Planning Models for Industrial Marketing and Purchasing Management"(hereinafter Turnbull).

As to claim 19, The Managerial Grid does not explicitly disclose the method according to claim 1, further comprising the steps of:

calculating the future value of an intangible asset by iterating said scoring, summing, transforming, and plotting steps using new rating levels, determined through a code in the format x, y, z where x is a number of improvement steps which the asset is likely to achieve if its current position is at a lowest performance level, y is a number of improvement steps that the asset is likely to achieve if its current position is at a next highest performance level, and z is a number of improvement steps the asset is likely to achieve if its current position is at a next highest performance level.

However, Turnbull discloses a system of strategic planning that enables management to assess by graphic representation the current position of a company, the projected future position of a company and the desired future position of a company (see abstract and page 7). Turnbull further discloses generating future business portfolios (i.e. calculating the future value of the intangible asset (what-if analysis)) based on project trends of the

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factors considered in order to identify major strategic issues facing the company (see page 12, last two paragraphs). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include calculating the future value of an intangible asset by iterating said scoring, summing, transforming, and plotting steps using new rating levels, determined through a code in the format x, y, z where x is a number of improvement steps which the asset is likely to achieve if its current position is at a lowest performance level, y is a number of improvement steps that the asset is likely to achieve if its current position is at a next highest performance level, and z is a number of improvement steps the asset is likely to achieve if its current position is at a next highest performance level within the Managerial Grid, Canguilhem, Copeland and Hamel in order to identify major strategic decisions facing the company (page 12, last paragraph).

As to claim 20, The Managerial Grid does not explicitly disclose the method according to claim 1, further comprising the steps of repeating said steps of establishing, scoring, summing, transforming, and plotting for a plurality of intangible assets of interest, whereby said chart is caused to show a plurality of points corresponding to said plurality of intangible assets of interest.

However, Turnbull discloses a system of strategic planning that enables management to assess by graphic representation the current position of a company, the projected future position of a company and the desired future position of a company (see abstract and page 7). Turnbull further discloses repeating said steps of establishing, scoring, summing, transforming, and

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plotting for a plurality of intangible assets of interest, whereby said chart is caused to show a plurality of points corresponding to said plurality of intangible assets of interest (i.e. the company is divided into strategic business units (SBUs) which are positioned on the business screen against two corporate dimensions)(see GEC's Nine Cell Strategic Business Screen, pages 13 and 14). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include repeating said steps of establishing, scoring, summing, transforming, and plotting for a plurality of intangible assets of interest, whereby said chart is caused to show a plurality of points corresponding to said plurality of intangible assets of interest within The Managerial Grid, Canguilhem, Copeland and Hamel in order to identify major strategic decisions facing the company (page 12, last paragraph).

Response to Arguments

9. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax

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telephone number for this group is (703) 305-7687 (for official communications including

After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th Floor, receptionist.

A handwritten signature in black ink, appearing to read "Alexander Kalinowski". The signature is fluid and cursive, with the first name "Alexander" and last name "Kalinowski" clearly distinguishable.

Alexander Kalinowski

Primary Examiner

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5/2/2004